

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Gek-Kee Sim et al.

Serial No.: 09/646,561

Filing Date: September 19, 2000

International Filing Date: March 19, 1999

For: T CELL COSTIMULATORY PROTEINS,
SEQUENCES AND USES THEREOF

Attorney Docket No.: HKZ-029CPUS

Group Art Unit: N/A

Examiner: N/A

Commissioner for Patents
Box PCT (EO/DO/US)
Washington, D.C. 20231

09/21/2001 LLANDERA 00000054 09646561

02-FC-241

03-FC-122

02-FC-241
03-FC-122

CERTIFICATE OF EXPRESS MAIL

Date of Deposit: September 17, 2001

Express Mail Label No.: EL 745889515 US

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, Box PCT (EO/DO/US), Washington, DC 20231.

Flidio P. Cardoso

Name of Person Mailing Paper

[Signature]

Signature of Person Mailing Paper

COMBINED RENEWED PETITION PURSUANT TO 37 CFR § 1.47(a)

Repln. Ref: 11/29/2001 MNGUYEN 0012323000
DAH:120080 Name/Number:09646561
FC: 704 \$130.00 CR

and

PETITION TO REVIVE AN ABANDONED APPLICATION

Adjustment date: 11/29/2001 MNGUYEN
09/21/2001 LLANDERA 00000054 09646561
02-FC:241 -620.00-OP
03-FC:122 -130.00-OP

Dear Sir:
Repln. Ref: 11/29/2001 MNGUYEN 0012315000
DAH:120080 Name/Number:09646561
FC: 704 \$620.00 CR

Applicants hereby renew their Petition pursuant to 37 CFR § 1.47(a) for acceptance of the enclosed Declaration for Patent Application when one of the co-inventors, Gek-Kee Sim, refuses to sign or cannot be reached. Applicants' first Petition pursuant to 37 CFR § 1.47(a), filed on February 1, 2001, was dismissed in a decision dated May 17, 2001. A request for the appropriate extension of time pursuant to 37 CFR 1.136(a) and appropriate fees are being filed herewith.

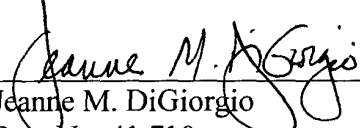
In the event that Applicants' Renewed Petition Pursuant to 37 CFR §1.47(a) is denied, Applicants hereby alternatively petition, pursuant to 37 CFR 1.137(b), to revive the above-referenced application which will have become unintentionally abandoned. Enclosed is the fee set forth in 37 CFR §1.17(m) based on small entity status.

Accordingly, it is respectfully requested that the above-identified application be revived from abandonment. A response to the outstanding Notification of Missing Requirements under 35 U.S.C. §371 (mailed from the Patent Office on November 1, 2000) is being filed concurrently herewith. It is respectfully submitted that the entire delay in filing the response from the due date for the response until the filing of this petition was unintentional.

In particular, Applicants submit herewith the unexecuted Declaration of the nonsigning co-inventor, Gek-Kee Sim, along with a separate Declaration of Timothy McCutcheon stating that the nonsigning co-inventor refuses to sign the Declaration. The executed Declarations of the other two co-inventors have been previously submitted. As disclosed in the attached Declaration of Timothy McCutcheon and the accompanying documentary evidence, diligent efforts have been made to present a copy of the application papers to the non-signing inventor, Dr. Sim. Despite multiple attempts to reach Dr. Sim by email messages and telephone messages to arrange a meeting to discuss the above-referenced application and despite the mailing of the above-referenced application and related documents to Dr. Sim at her last known address, Applicants have received no response. Accordingly, Applicants conclude that Dr. Sim either refuses to sign or cannot be reached.

Respectfully submitted,

LAHIVE & COCKFIELD, LLP


Jeanne M. DiGiorgio
Reg. No. 41,710
Attorney for Applicants

28 State Street
Boston, MA 02109
tel: (617) 227-7400
fax: (617) 742-4214

Date: September 17, 2001

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| CERTIFICATE OF EXPRESS MAIL | |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------|
| Date of Deposit: <u>September 17, 2001</u> | Express Mail Label No.: <u>EL 745 889515 US</u> |
| I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, Box PCT (EO/DO/US), Washington, DC 20231. | |
| <u>Filippo P. Cardosi</u> Name of Person Mailing Paper | <u>[Signature]</u> Signature of Person Mailing Paper |

DECLARATION OF TIMOTHY McCUTCHEON

Dear Sir:

I, Timothy McCutcheon, declare the following:

1. I am a patent attorney in the Intellectual Property Department of Heska Corporation, Assignee of the above-referenced patent application.
2. Gek-Kee Sim is a co-inventor of the above-referenced patent application and a former employee of Heska Corporation.
3. Dr. Sim was an employee at Heska Corporation from February 1, 1996 through August 25, 1998. The last known official addresses for Dr. Sim which Heska Corporation has on file are (1) 543 Franklin Street, Denver, CO 80218 and (2) simgk@aol.com. Heska Corporation also has a telephone number on file for Dr. Sim.

4. On July 13, 2001, I sent an email message to Dr. Sim informing her of my upcoming trip to Denver and asking her to meet me to review the above-referenced application and execute the related documents. A copy of this email is attached as Exhibit A.

5. The message described in paragraph 3 was also left as a voice message on the answering machine of Dr. Sim's telephone.

6. On July 17, 2001, I sent additional voice and email messages to Dr. Sim asking her to meet me during my trip to Denver to review the above-referenced application and execute the related documents. A sample copy of these messages is attached as Exhibit B.

7. On July 26, 2001, I sent a letter by Federal Express which was signed by Carol Talkington Verser (patent agent for the above-referenced application) and addressed to Dr. Sim at her last known address listed in paragraph 2 (above). Enclosed with this letter was a spiral-bound copy of the above-referenced application as filed and the Assignment and Declaration documents related to this application. This letter requested Dr. Sim to execute the enclosed documents and return them to Heska Corporation. A copy of this letter, its Federal Express airbill, and the Federal Express "Track Response" printout dated July 30, 2001, indicating that the package was received and signed for by G. Sim on July 27, 2001, are attached as Exhibit C.

8. On July 26, 2001, I sent another email message to Dr. Sim alerting her to the package mailed to her on the same day, described in paragraph 7 (above), and requesting her to contact me. A copy of the email is attached as Exhibit D.

9. On August 28, 2001, I left another voicemail message for Dr. Sim requesting that she sign the documents as soon as possible and certainly no later than September 7, 2001.

10. I have not received any response from Dr. Sim. Also, I do not know of anyone else at Heska Corporation who has received a response from Dr. Sim pertaining to the above-referenced application.

I have been warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the subject application or any patent resulting therefrom. I declare that all of the foregoing statements made of my own knowledge are true and that all statements made on information and belief are believed to be true.

Date: 9-14-01

Signed: Timothy L. McCutcheon

Timothy L. McCutcheon

IM-1-CI-PUS

McCutcheon, Timothy

From: McCutcheon, Timothy
 Sent: Friday, July 13, 2001 10:15 AM
 To: 'simgk@aol.com'
 Subject: Meet to sign patent documents?

Hello Gek Kee,

This is Tim McCutcheon in the IP department at Heska.

Carol has some documents relating to the patent covering T Cell Costimulatory proteins that she would like signed and I happen to be coming to Denver for meetings on both Wednesday and Friday next week. Carol will also be in Denver on Friday next week. We were wondering if you are available to meet with one of us on Wednesday or Friday. We'll be downtown, but we could meet wherever it is convenient for you. Early afternoon would probably be best for me, I think Carol may be more flexible with respect to time if you were to meet with her on Friday.

The documents are just the standard Declaration and Power of Attorney documents that are signed in all patent cases. We would also bring a copy of the complete patent specification and claims for your records.

I don't know how often you check your e-mail, so I'll also leave you a message on your answering machine.

Thanks

Tim

IM-1-CI-PUS

McCutcheon, Timothy

From: McCutcheon, Timothy
Sent: Tuesday, July 17, 2001 10:41 AM
To: 'simgk@aol.com'
Subject: Meeting in Denver

Hello again Gek Kee,

I haven't heard back from you on the phone messages I've left. Since it's not your voice on the machine, I hope I have the correct number.

I'm just continuing to try to reach you to see if you can meet with me on Wednesday or with Carol on Friday in Denver to sign some routine patent documents.

Thanks

Tim

edEx. USA Airbill FedEx Tracking Number **800700120186**

From (please print and press hard)
7/26/01 Sender's FedEx Account Number **1240-2891-4**
 To (please print and press hard)
Carol Talkington Verser, PhD Phone **(970) 493-7272**
HESKA CORP
1613 PROSPECT PARKWAY Dept./Floor/Suite/Room

FORT COLLINS State **CO** ZIP **80525-9769**

Your Internal Billing Reference Information (Optional) First 24 characters will appear on invoice
6520 1410-1700 and 3191-07

To (please print and press hard)
 Bill to
Gek-kee Sim, PhD Phone **(303) 321-8595**

Company
c/o 543 Franklin St. Dept./Floor/Suite/Room
Denver State **CO** ZIP **80218**
 We Cannot Deliver to P.O. Boxes or P.O. ZIP Codes

For HOLD at FedEx Location check here
☐ Hold Weekday (Not available with FedEx First Overnight)
☐ Hold Saturday (Not available at all locations and FedEx 2Day only)

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0200 Form I.D. No. **SPL21 Sender's Copy**

4a Express Package Service Packages under 160 lbs.
☒ FedEx Priority Overnight (Next business morning) ☐ FedEx Standard Overnight (Next business afternoon) ☐ FedEx 2Day* (Second business day) ☐ FedEx Express Saver* (Third business day)
 Delivery commitment may be later in some areas.

☐ FedEx First Overnight (Earliest next business morning delivery to select locations) (Higher rates apply) * FedEx Letter Note not available. Minimum charge: One pound rate.

4b Express Freight Service Packages over 150 lbs.
☐ FedEx Overnight Freight (Next business day) ☐ FedEx 2Day Freight (Second business day) ☐ FedEx Express Saver Freight (Up to 3 business days)
 Delivery commitment may be later in some areas.

(Call for delivery schedule. See back for detailed descriptions of freight services.)

5 Packaging ☐ FedEx Letter ☒ FedEx Pak ☐ FedEx Box ☐ FedEx Tube ☐ Other
 Declared value limit \$500

6 Special Handling
 Does this shipment contain dangerous goods? ☐ Yes (See our website Chapter 1, Declaration) ☐ No (Shipper's Declaration not required)
☐ Dry Ice (Dry Ice 5, UN 1845 III) (Dangerous Goods Shipper's Declaration not required) ☐ CA ☐ Cargo Aircraft Only

7 Payment
 Bill to: ☒ Sender (Account no. in section 1 will be billed) ☐ Recipient ☐ Third Party ☐ Credit Card ☐ Cash/Check
 (Enter FedEx account no. or Credit Card no. below)

FedEx Account No. **1240-2891-4** Exp. Date
 Credit Card No.
 Total Packages **1** Total Weight **1.00** Total Declared Value **\$0.00** Total Charges **\$0.00**

*When declaring a value higher than \$100 per shipment, you pay an additional charge. See SERVICE CONDITIONS, DECLARED VALUE, AND LIMIT OF LIABILITY section for further information.

8 Release Signature Sign to authorize delivery without obtaining signature.

Your signature authorizes Federal Express to deliver this shipment without obtaining a signature and agrees to indemnify and hold harmless Federal Express from any resulting claims.

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WCSL 0707 Rev. 01/00/01 PHS 01/00/01 ©1994-97 FedEx

Track Package

IM-1-C-1-PUS

Track Response

Date: 07/30/2001 Time: 04:18:22 PM

Reference Number Type: AW
Reference Number: 800700120186
Status Code: D
Status: Delivered
Location City: DENVER
Location State: CO
Location Country:
Status Date: 20010727 091600
Delivery Required By:
Ship Date: 20010726 162000
Estimated Delivery Date:
Delivered On: 20010727 091600
EPDI Date:
Consignee: CN
Shipper:
Service Level:
Service Description:
Signed By: G.SIMMS
Trace By Type: AW
Trace By Reference: 800700120186
Weight:
Weight Qualifier Code:
Weight Qualifier:
Weight Unit Code:
Weight Unit:
Origin City:
Origin State:
Origin Country:
Destination City:
Destination State:
Destination Country:



HESKA™

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www.heska.com

July 26, 2001

Via Federal Express

Gek-Kee Sim, Ph.D.
543 Franklin Street
Denver, Colorado 80218

RE: U.S. Application Serial No. 09/646,561, filed 19 September 2000, entitled
"T CELL COSTIMULATORY PROTEINS, SEQUENCES AND USES
THEREOF"
Our File No. IM-1-C1-PUS ✓

Dear Gek-Kee:

Please find enclosed a spiral-bound copy of the above-referenced application as filed. This application claims priority to the PCT application, which was filed in March of 1999.

Also enclosed is an "Assignment" and a "Declaration, Petition and Power of Attorney for Patent Application" for signature by you as an inventor of the above-referenced patent application. These documents were sent to us by Lahive & Cockfield, who is handling prosecution of this application. We would appreciate it if you would sign and date these documents and return them to us in the attached Federal Express package at your earliest convenience. If you need to make a correction to your name or address, please cross through the wrong items, print the correct information and initial the change. Also, if you can, please have signature notarized on the Assignment. If you have any questions, please feel free to call me. Thank you.

Sincerely,

Carol Talkington Verser, Ph.D.
Executive Vice President
Intellectual Property and Business Development

Encls.

Gordon, Susan

From: McCutcheon, Timothy
Sent: Thursday, July 26, 2001 4:19 PM
To: 'simgk@aol.com'
Cc: Verser, Carol; Gordon, Susan
Subject: FW: 2nd Revised Gek-kee e-mail

Importance: High

RE: U.S. Application Serial No. 09/646,561,
filed 19 September 2000, entitled
"T CELL COSTIMULATORY PROTEINS, SEQUENCES AND USES THEREOF"
Our File No. IM-1-C1-PUS (HKZ-029CPUS) ✓
and

[REDACTED]

Dear Gek-kee,

As a follow-up to my recent voice-mails and e-mails, we have sent to you by Federal Express today copies of the above-referenced U.S. patent applications, along with an Assignment and Declaration and Power of Attorney for each case, for your signature. We would greatly appreciate it if you would read each of these documents, sign at the places indicated and return the signed originals to us at your earliest convenience in the return self-addressed and prepaid FedEx envelope. If you have any questions at all, please feel free to contact me or Carol at 970/493-7272.

We look forward to receiving the signed documents and appreciate your assistance with this.

Regards,

Tim McCutcheon